



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,918	01/31/2001	Hideyuki Amaku	826.1671/JDH	9990
21171	7590	02/08/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,918

Applicant(s)

AMAKU ET AL

Examiner

Merilyn P. Nguyen

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 10-11 and 14-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

1. This application claims foreign priority Application No. 2000-181687 filed on June 16, 2000.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2005 has been entered.

3. In response to the communication dated 12/19/2005, claims 1-15 are active in this application.

Acknowledges

4. Receipt is acknowledged of the following items from the Applicant:
- The applicant's preliminary amendments have been considered and made of record.

Election/Restrictions

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I) Claims 1, 2, 3, 8, 9, 12 and 13, drawn to a recording method and a recording system classified in class 711, subclass 130.

Art Unit: 2163

II) Claims 4-7, 10 and 11, drawn to a retrieval system, classified in class 707, subclass 10.

III) Claims 14 and 15, drawn to a system performing and exchanging business transactions, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP j 806.04, MPEP j 808.01). In the instant case the different inventions, they have different modes of operation, group I performs recording operation which mean writing to a storage medium, group II performs retrieving operation which mean reading from a storage medium and group III performs tracking and exchanging business transactions, which normally dictates the effects or demonstrates the result of the scope of the invention.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Mr. Randall Beckers on February 03, 2006 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1, 2, 3, 8, 9, 12 and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-7, 10, 11, 14 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 2163

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the claim is directed to a judicial exception (law of nature, natural phenomena, or an abstract idea) which would make it non-statutory if it is directed to the exception itself, rather than a practical application of the exception. One way a practical application can be established is through claiming a physical transformation (data transformation is not a physical transformation and is not, in and of itself, evidence of statutory subject matter).

(2) Where there is no physical transformation being claimed, a practical application would be established by a useful, concrete and tangible result. That result is useful if it has specific, substantial and credible utility. Make a determination whether such is the case based on the perspective of one of ordinary skill having read the claim in light of the disclosure. It's concrete if it produces an assured, repeatable result (e.g., same input produces the same output each time the steps are performed). For it to be a tangible result, it must be more than just a

Art Unit: 2163

thought or a computation. Instead, it must have real world value rather than being an abstract result.

In the present case, claimed invention (Claim 13) merely recites the abstract idea of how to record the process information that does not apply, involve, use or advance the technological arts.

In the present case, claimed invention (Claim 12) does not produce tangible result since it includes **intangible media** such as **signals**, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 3, 8, 9, 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2 and 9, these claims are being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: devices are not structural connected to each other.

Art Unit: 2163

Regarding claims 8, 12 and 13, these claims are being incomplete because the step of recording the process information is not clearly connected to the step of generating process information.

Claim 3 depends on claim 2 therefore inheriting its defect.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakagaki (US 5,857,077).

Regarding claims 1, 8, 9, 12, and 13, Nakagaki discloses a recording system, a recording method, a computer-readable storage medium, and a propagating signal, comprising:

- a generation device generating process information for indicating a content of a process in a specific system (See col. 9, line 66 to col. 10, line 16); and
- a recording device for recording the process information of the specific system in a shared storage medium (Collected history holding section 17, Fig. 1, col. 10, lines 17-46) that is shared by a plurality of systems including the specific system and is commonly accessed by the plurality of systems (See Fig. 1, 7, and 9, as illustrated as two way arrows interchanging information with other information systems) and that collectively stores a plurality of pieces of process information of

the plurality of systems (See col. 10, lines 41-46), in a format such that a process information of the entire system comprising the plurality of systems is collectively managed by the shared storage medium (See col. 10, lines 41-46, wherein the collected history holding section 17 stores distribution histories collected from other information intervention systems) and a process history of the plurality of systems can be tracked without requiring access to the specific system (See col. 10, lines 47- 65, wherein a process history is tracked using the tracing analysis section 18 to tracking various pieces of information such as information transfer, distribution route etc. without requiring access to the specific system since all the information is stored in the collected history holding section 17).

Response to Remarks/Arguments

13. Applicant's remarks/arguments filed on 12/15/2005 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive.

Applicant argues that Nakagaki does not teach or suggest the newly amended limitation of the storage is a shared storage that stores and collectively manages the process information or transactions of the different systems and allows access to and tracking of the transactions or process history without requiring access to the different systems. The examiner respectfully point out that, as addressed above in claim 1, the collected history holding section 17 (corresponding to "a shared storage") stores distribution histories collected from other information intervention systems (See col. 10, lines 41-46), and wherein a process history can be

Art Unit: 2163

tracked using the tracing analysis section 18 to tracking various pieces of information such as information transfer, distribution route etc. without requiring access to the specific system since all the information is stored in the collected history holding section 17 (See col. 10, lines 47-65).

Allowable subject matter

14. Claims 2 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The reasons for allowance are stated in the previous Office Action mailed January 30, 2004.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
MN
February 03, 2006

Frantz Coby
FRANTZ COBY
PRIMARY EXAMINER